REMARKS

I. Summary of the Office Action

Claims 1-47 are pending in this application.

Claims 24 and 41 are rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

Claims 1, 3, 6, 8-13, 20-22, 24, 25, 27, 30, 32-34, 40 and 41 are rejected under 35 U.S.C. § 102(e) as being anticipated by Lawler et al. U.S. Patent No. 5,585,838 (hereinafter "Lawler").

Claims 2, 4, 5, 7, 23, 26, 28, 29, 31, and 42-47 are rejected under 35 U.S.C. § 103(a) as being obvious from Lawler.

Claims 14-16, 35, and 36 are rejected under 35 U.S.C. § 103(a) as being obvious from Lawler in view of Knee et al. U.S. Patent No. 5,589,892 (hereinafter "Knee").

Claims 17, 18, 37, and 38 are rejected under 35 U.S.C. § 103(a) as being obvious from Lawler in view of Lawler U.S. Patent No. 5,758,259 (hereinafter "Lawler 2").

Claims 19 and 39 are rejected under 35 U.S.C. § 103(a) as being obvious from Lawler in view of Harrison U.S. Patent No. 5,694,163 (hereinafter "Harrison").

II. Summary of Applicants' Reply

Applicants are submitting concurrently herewith a Request for Continued Examination, a Supplemental Information Disclosure Statement, and a Request to Change Correspondence Address.

Applicants have canceled claims 4 and 28 without prejudice. Applicants have amended claims 1-3, 5-26, 34, 36, and 41-44 to more particularly define the invention. Applicants have amended claims 37 and 38 to correct typographical errors. No new matter has been introduced as a result of these amendments.

The Examiner's rejections are respectfully traversed.

III. Summary of Examiner Interview

The undersigned and the undersigned's colleagues, Wesley Monroe* and Andrew Van Court, conducted a personal interview with the Examiner on March 16, 2005. The undersigned and his colleagues would like to thank the Examiner for the courtesies extended during the interview.

* Wesley Monroe participated in the interview via telephonic conference.

IV. Applicants' Reply to the § 112 Rejection

Claims 24 and 41 are rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. This rejection is respectfully traversed.

Applicants have amended claims 24 and 41 to more particularly define the invention. In particular, claims 24 and 41 have been amended to specify that schedule information for television programs (not television programs) is stored on a second database. In view of these amendments, applicants submit that amended claims 24 and 41 comply with the written description requirement.

This rejection should therefore be withdrawn.

V. Applicants' Reply to the § 102 Rejection

Claims 1, 3, 6, 8-13, 20-22, 24, 25, 27, 30, 32-34, 40 and 41 are rejected under 35 U.S.C. § 102(e) as being anticipated by Lawler. This rejection is respectfully traversed.

Independent claims 1 and 25 have been amended to more succinctly capture having a first network that receives television schedule information and television programming in different means.

Amended independent claims 1 and 25 specify a database for storing television schedule information and which communicates with a first network via a global computer network and a distribution facility that provides television programming and communicates with the first network via a communications path other than the global computer network. Thus, during operation of applicants' invention, a processor in the first network accesses the database over the global computer network to display a portion of the television schedule information and controls a storage device to store a television program selected from the displayed television schedule information and received from the distribution facility over the communications path other than the global computer network.

Lawler (in FIG. 1) describes a head end 12 that provides programming to viewer stations 16. Head end 12 includes a digital communication gateway 28 and a digital local area network (LAN) 24 that includes multiple computer servers 26, which may include service and application servers 30, continuous media servers 32, and electronic program guide servers (EPGS) 34 (see Lawler, column 5, lines 55-63). Data from EPGS 34 and television programs from analog feed 40

are received by viewer stations 16 from head end 12 over network 14.

Amended independent claims 1 and 25 are neither anticipated nor rendered obvious by Lawler for several reasons. First, the claim element of having a first network that receives television schedule information and television programming in different means (e.g., the database through a global computer network and the distribution facility through a communications path other than the global computer network) is in stark contrast to Lawler's approach to providing program guide information and television programming to viewer stations from the same source (i.e., head end 12). Although the Examiner indicated that head end 12 may receive data from sources external to the head end such as from a wide area network and an analog feed, this data and data provided by servers 26, however, are provided to viewer stations 16 only by head end 12. Thus, Lawler fails to show or suggest a database for storing television schedule information and a distribution facility that provides television programming, wherein the database communicates with a first network via a global computer network and the distribution facility communicates with the first network via a communications path other than the

global computer network, as specified in independent claims 1 and 25.

Secondly, applicants submit that Lawler fails to show or suggest a processor in the first network that accesses a database over the global computer network to display a portion of the television schedule information and controls a storage device to store a television program selected from the displayed television schedule and received from the distribution facility via a communications path other than the global computer network, as required by amended independent claims 1 and 25. Rather, in Lawler, a processor at viewing stations 16 may obtain program guide information from EPGS 34 and television programming over the same dedicated communications path (i.e., network 14). In fact, Lawler specifically states that head end 12 combines analog signals (e.g., television programs) and digital information (e.g., program guide information) into a composite signal and delivers the composite signal to viewer stations 16 over network 14 (see Lawler, column 6, lines 54-65). Thus, in Lawler, a processor at viewer stations is operative to obtain program guide information and television programs over a single dedicated communications path, whereas applicants' processor, which is

included in a first network, is operative to obtain television schedule information over global computer network and television programs over a path other than the global computer network.

Applicants respectfully submit that a dedicated communications path such as the path connecting head end 12 and viewer stations 16 or any of the internal connections within head end 12, such as local area network 24, are not a global computer network.

Moreover, even if it is contended that the dedicated communications path connecting head end 12 and viewer stations 16 could be a global computer network over which a processor at viewer stations can access television programming information, which it could not, Lawler fails to show or suggest a path other than this dedicated path for transmitting television programming.

Accordingly, because Lawler fails to show or suggest a processor, which is included in a first network, that accesses a database (for storing television schedule information) over a global computer network to display a portion of the television schedule information and which controls a storage device to store a television program

selected from the displayed television schedule information and received from the distribution facility over a communications path other than the global computer network, independent claims 1 and 25 are allowable over Lawler. Claims 3, 6, 8-13, 20-22, 24, 27, 30, 32-34, 40 and 41 are allowable for at least the reason they depend from either independent claim 1 or 25, which have been shown to be allowable.

VI. Applicants' Reply to the § 103 Rejections

A. The Lawler Rejection

Claims 2, 4, 5, 7, 23, 26, 28, 29, 31, and 42-47 are rejected under 35 U.S.C. § 103(a) as being obvious from Lawler.

1. Claims 2, 4, 5, 7, 23, 26, 28, 29, and 31

Applicants have canceled claims 4 and 28 without prejudice. The rejection of claims 4 and 28 is moot and should therefore be withdrawn.

Applicants have shown independent claims 1 and 25 to be allowable. Therefore, claims 2, 5, 7, 23, 26, 29, and 31 which depend from either independent claim 1 or 25, are allowable at least because they depend from allowable claims 1 and 25. The rejection of these claims should therefore be withdrawn.

2. Claims 42-47

Independent claim 42 has been amended to more particularly define the invention. In particular, independent claim 42 has been amended to specify a database for storing television schedule information and a processor included on a first network that communicates with the database via a public network. The processor accesses the database and receives a portion of the television schedule information over the public network.

The Examiner takes Official Notice as to the existence of the Internet (a type of public network) as a means for conducting bi-directional communication and contends that Lawler may utilize the Internet to establish communications between head end 12 and viewer stations 16 (see Office Action, page 13, lines 3-16). Contrary to the Examiner's contention, applicants submit that Lawler discusses a traditional cable provider system having a head end 12 and viewer stations 16 and cannot be modified to utilize the Internet to perform the functions required of Lawler's cable provider system. Lawler specifically states that head end 12 combines analog signals (e.g., television programs) and digital information (e.g., program guide information) into a composite signal and delivers

the composite signal to viewer stations 16 over network 14 (see Lawler, column 6, lines 54-65). Thus, integrating the Internet into Lawler would require transmitting television programs over the Internet. Clearly, Lawler does not teach or suggest transmitting television programs and program guide information over the Internet or a public network to viewer stations 16.

At best, Lawler suggests that the cable provider system shown in FIG. 1 may be implemented as "a satellite downlink transmission system" or "an electrically conductive cable network" or "an optically conductive cable network" (see Lawler, column 5, lines 46-52). None of the alternatives proposed by Lawler involves public networks or the Internet nor would it be obvious to modify any of the alternatives proposed by Lawler to involve public networks or the Internet. In fact, applicants respectfully submit that the these traditional cable provider systems discussed in Lawler are tantamount to different types of private networks, not a public network, as specified in independent claim 42.

Lawler also states at column 7, lines 3-6 that "communication from the head end 12 to the viewer stations 16 could be carried on a satellite downlink while communication in the other direction is carried on a terrestrial modem link."

Even assuming arguendo that using a modem to send data upstream to head end 12 involves a public network, Lawler still fails to show or suggest a processor that receives television schedule information over the public network, as specified in amended independent claim 42. In fact, Lawler fails to show or suggest a processor in viewer stations 16 that receives program guide information over a public network because Lawler only teaches transmitting program guide information and television programs downstream to viewer stations 16 as a composite signal over a dedicated private network. That is, in Lawler, transmitting data downstream to viewers stations 16 occurs across a private network and not a modem link.

In addition, the portion of Lawler relied upon by the Examiner (i.e., column 5, lines 41-46) for an alleged motivation to modify Lawler to use the Internet, in fact, provides no such motivation. Column 5, lines 41-46 of Lawler states:

> It should also be appreciated, however, that the particular components of the interactive viewing system 10 may be implemented in accordance with a variety of conventions, standards, or technologies without departing from the underlying concepts of the invention.

Applicants respectfully disagree, and submit that the above-cited portion, which when read in the context of Lawler as a whole, merely indicates that the cable provider system in Lawler can be implemented using different types of private networks. This portion does not provide any suggestion or motivation to modify Lawler to use the Internet to transmit television programs and program guide information from head end 12 to viewer stations 16, nor does it provide any motivation to modify Lawler to use a processor, which is included in a first network, to access a database for storing television schedule information over a public network.

Furthermore, even if Lawler could be modified to use the Internet as suggested by the Examiner, many of the elements on head end 12, such as those elements required to modulate and demodulate the composite signals, would require replacement with other elements not discussed in Lawler. Such replacement of elements would be contrary to the teachings of Lawler and thus would render Lawler's cable provider system inoperative.

For at least the reasons that Lawler fails to show or suggest a processor, which is included in a first network, that accesses a database (for storing television schedule information) over a public network to display a portion of the

television schedule information received over the public network and which controls a storage device to store a television program selected from the displayed television schedule information, and that is no motivation modify the communications link between head end 12 and viewer stations to be an Internet connection (a type of public network), applicants submit that independent claim 42 is allowable. Claims 43-47, which depend from amended independent claim 42, are allowable because they depend from allowable claim 42. The rejection of these claims should therefore be withdrawn.

B. The Lawler and Knee Rejection

Claims 14-16, 35, and 36 are rejected under 35 U.S.C. § 103(a) as being obvious from Lawler in view of Knee.

Claims 14-16, 35, and 36 depend from either independent claim 1 or 25, which have been shown to be allowable. Claims 14-16, 35, and 36 are allowable at least because they depend from allowable claims. The rejection of these claims should therefore be withdrawn.

C. The Lawler and Lawler 2 Rejection

Claims 17, 18, 37, and 38 are rejected under 35 U.S.C. § 103(a) as being obvious from Lawler in view of Lawler 2.

Claims 17, 18, 37, and 38 depend from either independent claim 1 or 25, which have been shown to be allowable. Claims 17, 18, 37, and 38 are allowable at least because they depend from allowable claims. The rejection of these claims should therefore be withdrawn.

D. The Lawler and Harrison Rejection

Claims 19 and 39 are rejected under 35 U.S.C. § 103(a) as being obvious from Lawler in view of Harrison.

Claims 19 and 39 depend from independent claims 1 and 25, respectively, which have been shown to be allowable. Claims 19 and 39 are allowable at least because they depend from allowable claims. The rejection of these claims should therefore be withdrawn.

VII. Applicants' Reply concerning Official Notice

A. Timing of Applicants' Traversal

The Office Action maintains that the Official Notice presented in the prior Office Actions as to the equivalence of 'VCRs' and 'digital storage devices' is maintained as an admission of fact because applicants allegedly did not timely traverse the Official Notice pursuant to the guidelines set forth in MPEP § 2144.03.

This Official Notice was (and still is) presented in relation to rejections of dependent claims 7, 31, and 46 (see, for example, page 10, lines 8-9 of the Office Action). However, in applicants' reply of November 13, 2003 and of July 26, 2004, applicants argued the patentability of independent claims from which dependent claims 7, 31, and 46 depend. Hence, in applicants' view, it was not necessary to address dependent claims 7, 31, and 46 and argue their patentability over the cited references separately from the patentability of the parent independent claims. This does not mean that applicants admitted the equivalence of "VCRs" and "digital storage devices." If the base independent claims are allowable, this issue with respect to the dependent claims 7, 31, and 46 is moot. Accordingly, applicants respectfully disagree with the Examiner's contention that applicants admitted the Examiner's above-mentioned official notice was correct.

B. Official Notice is an Assertion of Fact, Not a Conclusion

Official Notice is used to make an assertion of fact. See MPEP § 2144.03.

Applicants respectfully submit that the Official Notice taken by the Examiner asserts a conclusion, not a fact.

That is, the Official Notice asserting that 'VCRs' and 'digital storage devices' are *equivalent* is a conclusion, not a fact. An example of a factual assertion in this instance would be that VCRs and digital storage devices were both known to be capable of recording television programs. However, instead of using Official Notice to assert such a fact, as required by the MPEP § 2144.03, the Official Notice foregoes the factual assertion requirement and asserts a conclusion based on other underlying facts.

Furthermore, "equivalents" has many different legal meanings depending on the context. In the context of the Doctrine of Equivalents, there are many different possible analyses that could be appropriate, each relying on different sets of facts. See, Warner-Jenkinson Co. v. Hilton Davis Chemical, 510 U.S. 17, 40 (1997). Equivalence in the context of construction of a means-plus-function element under § 112, paragraph 6 is different from the Doctrine of Equivalents. D.M.I. Inc. v. Deer & Co., 755 F.2d 1570 (Fed. Cir. 1985). Further, "two structures that are equivalent in one environment may not be equivalent in another." IMS Technology Inc. v. Haas Automation Inc., 206 F.3d 1422, 1436 (Fed. Cir. 2000).

Equivalence is a complex determination that is based on a number of underlying facts peculiar to the particular situation and type of equivalence being determined. Applicants maintain that whether a VCR is "equivalent" to a "digital storage device" depends on the type of equivalence, context of the claim, the invention, the prior art, and many other factors (i.e., facts) in each particular instance.

Therefore, in view of the foregoing, and if the Examiner maintain the rejection of claims 7, 31, and 46, applicants respectfully request that the Examiner modify the Official Notice to assert a fact such as, for example, that digital storage devices and VCRs are both capable of recording television programs, and based on such a factual assertion, the Examiner may assert that VCR's and digital storage devices are equivalent for the purposes of a specific claim rejection.

VIII. Conclusion

In view of the foregoing, claims 1-3, 5-27, and 29-47 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

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